

**REMARKS/ARGUMENTS**

Claims 45-53 and 68-69 are pending. Claims 1-44 and 54-67 were canceled by previous amendment. Claims 45 and 53 have been amended herein. New claims 68 and 69 have been added herein. No claim has been canceled herein.

***Oath/Declaration***

While Applicant asserts that no new matter was added by preliminary amendment filed October 26, 2004, in order to expedite prosecution, enclosed herewith is a new oath/declaration executed by the inventor.

***Claim Amendments***

Claim 45 has been amended herein to recite an aqueous treating composition comprising tannic acid having a gallic acid content of less than about 3.0 parts by weight (pbw), wherein the tannic acid is present in the aqueous treating composition at up to about 0.5 pbw, based on a total weight of the aqueous treating composition. No new matter has been added by this amendment. Support can be found throughout the specification and specifically at, *inter alia*, claim 45 before amendments following the telephone interview of October 18, 2005. Because the present amendments to claim 45 reverse amendments made in response to the Office Action mailed July 27, 2005, following the telephone interview of October 18, 2005, Applicant expressly denies surrender of subject matter and/or equivalents relating to the amendments in the response dated October 28, 2005.

Claim 53 has been amended herein to recite, *inter alia*, the fluorochemical is present at from about 0.001 pbw to about 5.0 pbw, based on a total weight of the aqueous treatment composition. No new matter has been added by this amendment. Support can be found throughout the specification and specifically at, *inter alia*, page 9, line 30 of the specification, as filed.

***New Claims***

New claim 68 recites the treating composition of claim 45, wherein the tannic acid has a gallic acid content of less than about 2.87 pbw. No new matter has been added with this new claim. Support can be found throughout the specification and specifically at, *inter alia*, Table 4 (page 38), Table 6 (page 41), Table 8 (page 44), and Table 10 (page 47) in the specification, as filed.

New claim 69 recites the treating composition of claim 45, wherein the tannic acid has a gallic acid content of less than about 1.0 pbw. No new matter has been added with this new claim. Support can be found throughout the specification and specifically at, *inter alia*, page 6, line 24 of the specification, as filed.

***Claim rejections under 35 U.S.C. § 112***

The Office Action has rejected claims 45 and 53 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement.

The Office Action alleges that the phrase “based on the weight of [the] tannic acid,” as stated in claim 45, is new matter but that the specification is clear that the gallic acid content is based on the tannic acid and, therefore, the phrase is redundant. Claim 45, as amended herein, does not recite the phrase “based on the weight of the tannic acid.” Therefore, this rejection is obviated.

The Office Action also alleges that the phrase “in a concentration of from greater than 0 pbw,” as stated in claim 45, is new matter. While the specification is clear that the tannic acid may be present in the claimed concentration range, the claims calling for a composition with “less than X%” of a substance do not call for a composition having 0% of the substance, but, rather, a composition which contains some amount of the substance, however small, with X% as maximum. *Ex parte Adams*, 77 U.S.P.Q. (BNA) 482 (1947). (A copy of *Ex parte Adams* is enclosed herewith for the Examiner’s convenience.) One of ordinary skill in the art would understand the phrase “present . . . at up to about X pbw” to be analogous to the phrase “less than X%.” The phrase “in a concentration of from greater than 0 pbw” is, therefore, redundant in view of either the specification or the legal meaning of “at up to about 0.5 pbw.” Claim 45, as

amended herein, does not recite the phrase “in a concentration of from greater than 0 pbw.” Therefore, this rejection is obviated.

The Office Action also alleges that the phrase “0.0001 pbw to about 5.0 pbw,” as stated in claim 53, is new matter. While the fluorochemical can be present in the inventive compositions in any concentration, in order to expedite prosecution, claim 53 has been amended herein to recite “0.001 pbw to about 5.0 pbw.” Therefore, this rejection is overcome.

***Rejections under 35 U.S.C. § 103(a)***

As an initial matter, the Office Action does not reject the pending claims under 35 U.S.C. § 102(b), thereby indicating that these claims are not anticipated by the cited references.

***De Lathauwer***

Claims 45-50 and 52 have been rejected under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 5,738,688 to De Lathauwer (“De Lathauwer”). Applicant respectfully disagrees.

De Lathauwer does not render the claimed compositions obvious. That is, De Lathauwer provides no motivation or suggestion to use “tannic acid having a gallic acid content of less than about 3.0 parts by weight (pbw)” to practice its disclosed compositions. See MPEP § 2143 (“The teaching or motivation to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure.”) (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). In fact, as conceded by the Office Action, “De Lathauwer is silent with respect to the gallic acid content.” Instead of teaching that the gallic acid content of the tannic acid can be less than about 3.0 parts by weight, De Lathauwer discloses that “[a]ccording to the invention, any commercial tannic acid can be used,” (see U.S. Patent No. 5,738,688; column 2; lines 66-67), presumably including tannic acids that do not have a gallic acid content of less than about 3.0 parts by weight. Thus, De Lathauwer fails to provide any motivation to select tannic acid having a gallic acid content of less than about 3.0 parts by weight. Therefore, De Lathauwer cannot render obvious amended claim 45 or those claims depending therefrom (*i.e.*, claims 46-53 and 68-69).

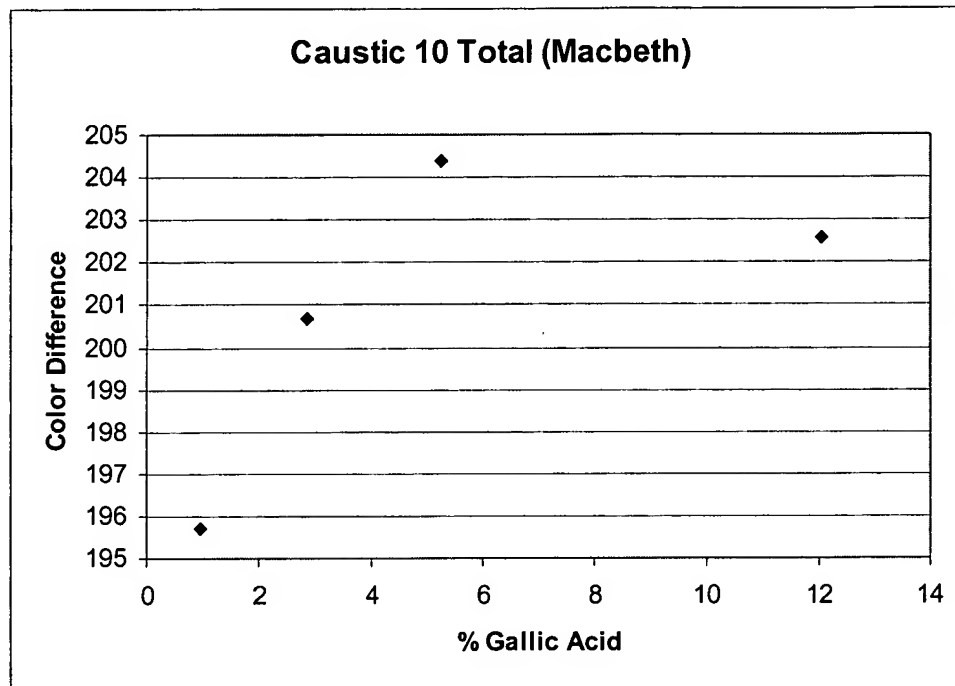
Even if the selection of tannic acid having a gallic acid content of less than about 3.0 parts by weight were rendered *prima facie* obvious by De Lathauwer, *which it is not*, such a rejection of the present claims would be rebutted by unexpectedly superior results achieved when selecting tannic acid having a gallic acid content of less than about 3.0 parts by weight, as shown in the specification as filed.

Specifically, the compositions of the present invention have markedly improved resistance to discoloration, or “browning,” which can be caused by contact of the treated fiber, yarn, or carpet with relatively high pH cleaning compositions. Such contact can occur frequently during routine maintenance of the treated fiber, yarn, or carpet. The tendency of a treated fiber, yarn, or carpet to “brown” when contacted with high pH cleaning compositions can be evaluated, for example, by measuring the color difference in a treated fiber, yarn, or carpet before and after application of a 10% by weight sodium hydroxide solution (“Caustic 10”; *see* specification at page 30). The color difference can be evaluated, for example, by using a Macbeth contact spectrophotometer model 20/20 (“Macbeth”). *See* specification at page 30.

As described at page 31 of the specification, four tannic acids having differing gallic acid contents were evaluated. The “Caustic 10” test, using the “Macbeth” measurement method, was used to evaluate samples of treated fiber, yarn, or carpet, as set forth in Table 4 (page 38), Table 6 (page 41), Table 8 (page 44), and Table 10 (page 47) of the specification, as filed. Exemplary results are summarized below:

| <b>Tannic Acid</b>            | <b>% Gallic</b> | <b>Caustic 10<br/>(Macbeth)</b> |
|-------------------------------|-----------------|---------------------------------|
| <b>ASP</b>                    | 0.96            | 195.7                           |
| <b>3SP</b>                    | 2.87            | 200.7                           |
| <b>CLM</b>                    | 5.26            | 204.4                           |
| <b>BAYGARD®<br/>CL Liquid</b> | 12.05           | 202.6                           |

A lower “Macbeth” measurement for the Caustic 10 test denotes that the samples have a smaller change in coloration (*i.e.*, less “browning”) due to exposure to a 10% by weight sodium hydroxide solution; this indicates superior stain resistance. Close inspection of these results reveals that the color difference (“Macbeth”) between samples before and after contact with a 10% by weight sodium hydroxide solution is unexpectedly lower for samples treated with tannic acid having less than about 3% gallic acid, as shown in the graph below:



Consequently, De Lathauwer cannot render obvious amended claim 45 or those claims depending therefrom. In the same way, De Lathauwer fails to provide motivation to select tannic acid having a gallic acid content of less than about 2.87 parts by weight or of less than about 1.0 part by weight. Therefore, De Lathauwer cannot render obvious new claims 68 and 69.

### ***Gamblin***

Claims 45-47 have been rejected under 35 U.S.C. § 103(a) as allegedly being obvious over to Gamblin (4,482,646). Applicant respectfully disagrees.

Like De Lathauwer, U.S. Patent No. 4,842,646 to Gamblin (“Gamblin”) does not render the claimed compositions obvious. Specifically, Gamblin provides no motivation or suggestion to use “tannic acid having a gallic acid content of less than about 3.0 parts by weight (pbw).” See MPEP § 2143. In fact, as conceded by the Office Action, “Gamblin is silent with respect to the gallic acid content.”

While the Office Action alleges that Gamblin in view of ordinary skill in the art renders the pending claims *prima facie* obvious, *which it does not*, such a rejection would be rebutted by unexpectedly superior results achieved when selecting a tannic acid having a gallic acid content of less than about 3.0 parts by weight, as set forth above.

Consequently, Gamblin cannot render obvious amended claim 45 or those claims depending therefrom. In the same way, Gamblin fails to provide motivation to select tannic acid having a gallic acid content of less than about 2.87 parts by weight or of less than about 1.0 part by weight; therefore, Gamblin cannot render obvious new claims 68 and 69.

***Fekete***

Claims 45-47 have been rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Fekete (4,0984,701). Applicant respectfully disagrees.

Like De Lathauwer and Gamblin, U.S. Patent No. 4,094,701 to Fekete (“Fekete”) does not render the claimed compositions obvious. Specifically, similar to the above discussion, Fekete provides no motivation or suggestion to use “tannic acid having a gallic acid content of less than about 3.0 parts by weight (pbw).” See MPEP § 2143. In fact, as conceded by the Office Action, “Fekete is silent with respect to the gallic acid content.”

While the Office Action alleges that Fekete in view of ordinary skill in the art renders the pending claims *prima facie* obvious, *which it does not*, such a rejection would be rebutted by unexpectedly superior results achieved when selecting a tannic acid having a gallic acid content of less than about 3.0 parts by weight, as set forth above.

Consequently, Fekete, like De Lathauwer and Gamblin, cannot render obvious amended claim 45 or those claims depending therefrom. In the same way, Fekete fails to provide motivation to select tannic acid having a gallic acid content of less than about 2.87 parts by weight or of less than about 1.0 part by weight; therefore, Fekete cannot render obvious new claims 68 and 69.

***De Lathauwer in view of Jones, Jr.***

Claims 51 and 53 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over De Lathauwer in view of U.S. Patent No. 5,520,962 to Jones, Jr. Applicant respectfully disagrees.

In order to render a claim obvious, the asserted combination must teach or suggest all claim limitations. MPEP § 2143.03 (citing *In re Royka*, 180 U.S.P.Q. 580 (C.C.P.A. 1970) (stating that all claim limitations must be taught or suggested by the prior art)). The pending claims, including claims 51 and 53, recite, *inter alia*, a gallic acid content of less than about 3.0 parts by weight element. Neither De Lathauwer nor Jones, Jr. teaches or suggests a tannic acid having a gallic acid content of less than about 3.0 parts by weight. In fact, as conceded by the Office Action, “De Lathauwer is silent with respect to the gallic acid content.”

Because neither De Lathauwer nor Jones, Jr. teaches or suggests this element, the combination of De Lathauwer in view of Jones, Jr. fails to teach or suggest all recited claim limitations and, therefore, cannot render *prima facie* obvious the pending claims. Even assuming *arguendo* that the cited combination rendered *prima facie* obvious the pending claims, *which it does not*, such a rejection would be rebutted by unexpectedly superior results achieved when selecting tannic acid having a gallic acid content of less than about 3.0 parts by weight, as set forth above.

***Combinations of De Lathauwer, Gamblin, Fekete, and/or Jones, Jr.***

Because, as set forth above, neither De Lathauwer, nor Gamblin, nor Fekete, nor Jones, Jr. teaches or suggests tannic acid having a gallic acid content of less than about 3.0 parts by weight, any combination of De Lathauwer, Gamblin, Fekete, and/or Jones, Jr. fails to teach or suggest all claim limitations, as required to render a claim *prima facie* obvious. MPEP § 2143.03.

Even assuming *arguendo* that a combination rendered *prima facie* obvious the pending claims, *which it does not*, any such rejection would be rebutted by unexpectedly superior results achieved when selecting tannic acid having a gallic acid content of less than about 3.0 parts by weight, as set forth above.

***Obviousness-Type Double Patenting***

Claims 45-53 have been rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 62-67 of Jones, Jr. in view of De Lathauwer. Applicant respectfully disagrees.

First, the Office Action fails to analyze the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are required for establishing a background for determining obviousness under 35 U.S.C. § 103 when making an obvious-type double patenting analysis. MPEP § 804 (II)(B)(1). For example, the Office Action does not:

- (A) Determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue;
- (B) Determine the differences between the scope and content of the patent claim and the prior art as determined in (A) and the claim in the application at issue;
- (C) Determine the level of ordinary skill in the pertinent art; and
- (D) Evaluate any objective indicia of nonobviousness.

Nonetheless, in order to expedite prosecution, Applicant addresses the rejection and asserts that the Office Action *cannot*, under any proper analysis, set forth a *prima facie* nonstatutory obviousness-type double patenting rejection. Specifically, the cited claims of Jones, Jr. do not recite “tannic acid having a gallic acid content of less than about 3.0 parts by weight.” Likewise, De Lathauwer fails to teach or suggest “tannic acid having a gallic acid content of less than about 3.0 parts by weight.” In fact, the Office Action concedes that “De Lathauwer is silent with respect to the gallic acid content.” Instead, the Office Action summarily concludes that the



“claims overlap in subject matter.” However, even under the doctrine of nonstatutory obviousness-type double patenting, all claim limitations must be taught or suggested.

Because the claims of Jones, Jr. do not recite this element and because De Lathauwer does not teach or suggest this element, the cited combination is not coextensive with the pending claims and, therefore, cannot render *prima facie* obvious the pending claims under the doctrine of nonstatutory obviousness-type double patenting.

Even assuming *arguendo* that the cited combination is coextensive with the pending claims, *which it is not*, and that the pending claims are *prima facie* obvious under the doctrine of nonstatutory obviousness-type double patenting in view of that combination, *which they are not*, such a rejection would be rebutted by unexpectedly superior results achieved when selecting tannic acid having a gallic acid content of less than about 3.0 parts by weight, as set forth above.



**CONCLUSION**

In light of the above arguments and amendments, the claims are believed to be allowable, and Applicant respectfully requests notification of same. The Examiner is invited and encouraged to directly contact the undersigned if such contact may enhance the efficient prosecution of the application to issuance. No fee is believed due. However, the Commissioner is hereby authorized to charge any fees that may be required or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

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D. Brian Shortell, J.D., Ph.D.

March 23, 2006

Date